



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

cl

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

11

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/543,771

Applicant(s)

CARULLI ET AL.

Examiner

Sumesh Kaushal

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 14-23, drawn to an isolated amino acid sequence (SEQ ID NO:4) and a method of altering the bone development in a host by administering the amino acid sequence, classified in class 514, subclass 2.
 - II. Claims 2-3 and 10-13, drawn to method of identifying molecule involved in bone modulation comprising identifying a molecule that binds to HBM or inhibits binding of HBM to a molecule, a method of testing HBM activity by identifying a protein that binds to an HBM protein, a pharmaceutical composition comprising the protein that binds to HBM protein, classified in class 435, subclass 7.1.
 - III. Claims 4-9, drawn to method for identifying a protein involved in bone modulation comprising identifying a protein that has an expression level that is different in a first host comprising Zmax1 gene when compared to host comprising HBM gene, classified in class 424, subclass 9.1.
 - IV. Claims 24 and 25, drawn to method of treating bone development disorders and a diagnostic assay, which requires the use of an antibody to HBM protein, classified in class 424, subclass 130.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and IV are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the

Art Unit: 1633

inventions of Group I and IV are distinct because the invention of Group I requires the use of HBM protein, whereas the invention of group IV requires the use of an antibody to HBM protein. Antibodies and proteins have different structure and functions and different modes of operation. Furthermore, the antibodies can also be made from the HBM polypeptides that can be isolated from cells endogenously expressing the polypeptide, rather than by recombinant means. Thus, these inventions are mutually exclusive and are of separate use.

3. Inventions II and III distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In instant case method of identifying a molecule that binds to HBM is distinct from a method to identify a molecule that modulate bone development in a host having a *high bone mass* or *low bone mass* phenotype. The method of Group II. Thus, these inventions are mutually exclusive and are of separate use.

4. In addition, Group I and IV are distinct from Group II and III because they have different modes of operation, different functions, or different effects. For example, the binding of an antibody to HBM is distinct from the binding of ApoE to HBM due inherent structural and function differences between antibody and ApoE. Furthermore, identification of a protein that modulate bone development in a host having a high bone mass or low bone mass phenotype requires quantitative analysis of host samples on 2D protein gels, which is distinct from above methods. Thus these inventions are distinct and are of separate use.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.


Art Unit: 1633

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Deborah Clark can be reached on (703) 305-4051. The fax-phone number for the organization where this application or proceeding is assigned as (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst Tracey Johnson, whose telephone number is (703) 308-0377. If the claims are amended canceled and/or added the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>) and A CLEAN COPY OF ALL PENDING CLAIMS IS REQUESTED to facilitate further examination.

SUMESH KAUSHAL
PATENT EXAMINER



SUMESH KAUSHAL
PATENT EXAMINER